

## REMARKS

Claims 8 – 25 remain in the application and stand finally rejected. Claims 1 – 7 are previously canceled without prejudice as being drawn to a non-elected invention. The final rejection is respectfully traversed.

The MPEP provides in pertinent part “the examiner should always look for enabled, allowable subject matter and communicate to applicant what that subject matter is at the earliest point possible in the prosecution of the application.”<sup>1</sup>

The Final Office action (Final) objects<sup>2</sup> to the specification for not providing antecedent basis for a “computer usable medium” as recited.

“The meaning of every term used in any of the claims should be **apparent** from the descriptive portion of the specification with clear disclosure as to its import;”<sup>3</sup> ... .”  
Moreover,

While an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is **departed from by amendment** of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims.<sup>4</sup>

Thus, there is no antecedent basis requirement for the claims, as filed, set forth in 35 USC or 37 CFR or otherwise explained in the MPEP. Instead, the meaning must be apparent<sup>5</sup>. Applicants assert that the meaning of the claims, as filed, is apparent from the specification, which describes: “[a]n executable code module or data generation module

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<sup>1</sup> MPEP §2164.04 (emphasis original).

<sup>2</sup> Final, #3, page 2.

<sup>3</sup> MPEP §608.01(o) (emphasis added).

<sup>4</sup> *Id* (emphasis added).

<sup>5</sup> *Supra*.

106 generates variable data, e.g., from system monitored parameters, which may be stored in input data **store 108**. Preferably, input data **store 108 is non-volatile storage**, although, any suitable **volatile storage** may be used as well.<sup>6</sup> Therefore, applicant believes that the application, as filed, sufficiently provides an apparent meaning for the recitations of the claims, as filed. Be that as it may, the specification is amended herein to provide additional support. No new matter is added<sup>7</sup>. Entry of the amendment, reconsideration and withdrawal of the objection to the specification is respectfully requested.

Claims 8 – 25 are finally rejected under 35 U.S.C. §112 as failing the written description requirement. “Specifically, variable data being time varying data is not described in the specification nor even used.”<sup>8</sup> The final rejection is respectfully traversed.

“The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.”<sup>9</sup> In other words, “variable data being time varying data<sup>10</sup>” need not be recited or used.

“Since the system status information may be **changing, constantly**, a typical such web interface application is designed to dynamically build and rebuild new web pages with every information change.”<sup>11</sup> Constantly changing certainly describes time varying. “The typical interface may provide web pages built from a collection of hypertext mark

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<sup>6</sup> Paragraph 0016 (emphasis added); *see also*, Brewer et al., serial No. 09/852,959.

<sup>7</sup> MPEP §§608.01(i) and 608.04 (“In establishing a disclosure, applicant may rely not only on the specification and drawing as filed but also on the original claims if their content justifies it.”).

<sup>8</sup> Final, #4, page 2.

<sup>9</sup> MPEP §2163.02.

<sup>10</sup> *Supra*.

<sup>11</sup> Paragraph 0003 (emphasis added).

up language (HTML) files with placeholders in markup text for receiving and **displaying dynamic input data**.<sup>12</sup> Dynamic data is also understood to be varying. “An executable code module can generate **variable data**, which another executable code module receives and combines with the HTML template files to produce complete HTML documents.<sup>13</sup>” “Thus, there is a need for an efficient collaborative design system for designing web-based management interfaces and for **collecting variable data** and passing collected data for display in web pages provided by the particular web-based management interface.<sup>14</sup>” “An executable code module or data generation module 106 **generates variable data**, e.g., **from system monitored parameters**, which may be stored in input data store 108.<sup>15</sup> “[S]ystem monitored parameters<sup>16</sup>” are time varying, otherwise, what is the point of monitoring? So, “**during operation**, the data generation module 106 **receives and formats raw system data** and stores it, locally in data store 108.<sup>17</sup>” “The data generation module 106 must **provide whatever variable data** is necessary **and in the proper format**.<sup>18</sup>” So, the specification describes “variable data being time varying data<sup>19</sup>” and, therefore, satisfies the written description requirement under 35 U.S.C. §112. Reconsideration and withdrawal of the final rejection of claims 8 – 25 under 35 U.S.C. §112 is respectfully requested.

Claims 8 – 25 are finally rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter, citing MPEP 2106.01 for authority. The final rejection is respectfully traversed.

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<sup>12</sup> *Id.*, (emphasis added).

<sup>13</sup> *Id.*, (emphasis added).

<sup>14</sup> Paragraph 0005 (emphasis added).

<sup>15</sup> Paragraph 0016 (emphasis added).

<sup>16</sup> *Id.*

<sup>17</sup> Paragraph 0018 (emphasis added).

<sup>18</sup> Paragraph 0019 (emphasis added).

<sup>19</sup> *Supra.*

This Manual is published to provide U.S. Patent and Trademark Office (USPTO) patent examiners, applicants, attorneys, agents, and representatives of applicants with a **reference work on the practices and procedures** relative to the prosecution of patent applications before the USPTO. It contains **instructions to examiners**, as well as other material in the nature of information and interpretation, and outlines the current procedures which the examiners are required or authorized to follow in appropriate cases in the normal examination of a patent application. The Manual **does not have the force of law** or the force of the rules in Title 37 of the Code of Federal Regulations. ...

**Examiners will be governed by** the applicable statutes, rules, **decisions**, and orders and instructions issued by the Director of the USPTO and other officials authorized by the Director of the USPTO.<sup>20</sup>

As applicants previously noted, “*State Street Bank*<sup>21</sup> involved ‘a data processing system for managing a financial services configuration of a portfolio established as a partnership,’ and ‘[g]iven the complexity of the calculations, a computer or equivalent device [wa]s a virtual necessity to perform the task.’ *Id.* at 1371.<sup>22</sup>” In deciding *Comiskey* the CAFC concluded “that independent claims 17 and 46 (and their dependent claims) and dependent claims 15, 30, 44, and 58 recite **statutory subject matter** [and therefore] remand[ed] to the PTO to determine whether the addition of a **general purpose computer** or modern **communication devices** to *Comiskey*’s otherwise unpatentable **mental process** would have been obvious.<sup>23</sup>” So, in *Comiskey* the CAFC sets forth a bright line rule for determining whether claims encompass patentable subject matter. Specifically, claims “combining the use of machines with a mental process, claim patentable subject matter.<sup>24</sup>” As a result, the CAFC reversed and returned the *Comiskey* application to the PTO to consider obviousness of those statutory claims.

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<sup>20</sup> MPEP, Forward (emphasis added).

<sup>21</sup> *State Street Bank*, 149 F.3d at 1377.

<sup>22</sup> *In re Comiskey*, Case No. 2006-1286 (hereinafter *Comiskey*), bridging sentence, pages 12 – 13 (Fed. Cir., September 20, 2007).

<sup>23</sup> *Id.*, page 2, lines 14 – 18 (emphasis added).

<sup>24</sup> *Id.*, page 24, lines 1 – 2.

Claims 8 and 14 correspond to *Comiskey* claim 17<sup>25</sup>. Applying the *Comiskey* rationale to the claimed collaborative design system that includes “data generation module ...;” a collection of HTML template files and a “page generation module,” combines “the use of machines with a mental process, claim patentable subject matter.”<sup>26</sup> Therefore, under the *Comiskey* bright line rule that “Examiners will be governed by<sup>27</sup>,” claims 8, 14 and claims depending therefrom “claim patentable subject matter.”<sup>28</sup>

Claims 17 – 19, 24 and 25 recite a “**computer program product** for managing a **system**, said **computer** program product comprising a **computer usable medium** having **computer** readable program code **stored** thereon,”<sup>29</sup> ... .” Certainly claims 17 – 19, 24

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<sup>25</sup> Claim 17 states in full:

A **system** for mandatory arbitration resolution regarding one or more unilateral documents comprising:

a **registration module** for enrolling or registering the person who is executing and the one or more unilateral documents in a mandatory arbitration system;

an **arbitration database** for storing arbitration language for insertion in the unilateral document wherein the arbitration language provides that any challenge to the unilateral document must be presented to the mandatory arbitration system for binding arbitration and for providing this arbitration language to the enrolling person;

an **arbitration resolution module** for enabling a complainant to submit a request for arbitration resolution; and

a **means for selecting** an arbitrator from an arbitrator database to conduct an arbitration resolution, for providing support to the arbitrator, and where the arbitrator determines an award or a decision that is final and binding.

*Comiskey*, footnote 3 (emphasis added).

<sup>26</sup> *Supra*.

<sup>27</sup> *Supra*.

<sup>28</sup> *Id*.

<sup>29</sup> Claim 17, lines 1 – 3 (emphasis added).

and 25 “could require the use of a computer<sup>30</sup>” and therefore, encompass patentable subject matter<sup>31</sup>.

Moreover, Claims 17 – 19, 24 and 25 are directed to “‘functional descriptive material’ [i.e., material which] consists of data structures and computer programs which impart functionality when employed as a computer component.<sup>32</sup>” The MPEP is instructive on the pre-*Comiskey* USPTO position on computer program product claims<sup>33</sup>. Furthermore,

a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and **is thus statutory**. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material *per se* from claims that define statutory inventions<sup>34</sup>.

Thus, in interpreting *Lowry*, the MPEP relies on a clear delineation that “**examiners are required or authorized to follow**<sup>35</sup>.” So, with regard to claims 17 – 19, 24 and 25, *Comiskey*, *Lowry* and the MPEP all clearly indicate that a “computer-readable medium

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<sup>30</sup> *Comiskey*, page 22, “Discussion” II C, (“These claims (17 and 46), under the broadest reasonable interpretation, could require the use of a computer as part of *Comiskey*’s arbitration system.”).

<sup>31</sup> *Id.*

<sup>32</sup> MPEP §2106.01.

<sup>33</sup> *Id.*, pg. 2100-17 (When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)(discussing patentable weight of data structure limitations in the context of a statutory claim to a data structure stored on a computer readable medium that increases computer efficiency) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory).).

<sup>34</sup> *Id.* §§I second paragraph, pg. 2100-18 (emphasis added).

<sup>35</sup> *Supra* (emphasis added).

encoded with a computer program is a computer element ... **is thus statutory**<sup>36</sup>.”

Therefore, because claims 17 – 19, 24 and 25 recite “a computer usable medium having computer readable program code stored thereon<sup>37</sup>,” that provides “a useful, concrete and tangible result<sup>38</sup>,” claims 17 – 19, 24 and 25 are directed to patentable subject matter under 35 U.S.C. §101. Reconsideration and withdrawal of the final rejection to claims 8 – 25 under 35 U.S.C. §101 is respectfully requested.

Claims 8 – 25 are finally rejected under 35 U.S.C. §103(a) over U.S. Patent Application No. 2003/00144442 to Shiigi et al. in view of U.S. Patent No. 6,424,980 to Iizuka et al. and U.S. Patent No. 6,981,207 to Bakeman et al. The final rejection is respectfully traversed.

Acknowledging that neither Shiigi et al. or Iizuka et al. teaches “data generation module receiving raw data said raw data being time-varying data, variable data being generated from said time varying data for up to date display;<sup>39</sup>” the Final turns to Bakeman et al. col. 11, lines 1 – 11 and Fig. 3 for this.

“The preferred implementation will contain **general data** explaining the generic operation of the configurable system, together with **system specific data as configured**. Preferably, generic and specific advice relating to configuration will be placed in proximity to system information relating specifically to the **system being documented**.<sup>40</sup>” “The client workstation 150 enables access to the Exchange servers with sufficient access rights to allow a program running thereon to access the required **configuration data in the registry** and in the Exchange directory.<sup>41</sup>” “After program

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<sup>36</sup> *Supra*.

<sup>37</sup> Lines 2 – 3.

<sup>38</sup> *Supra*.

<sup>39</sup> Claim 8, lines 5 – 7, claim 14, lines 4 – 6 and claim 17, lines 4 – 6.

<sup>40</sup> Bakeman et al., col. 9, lines 48 – 53 (emphasis added).

<sup>41</sup> *Id*, col. 10, lines 1 – 4 (emphasis added).

initialization 200, the collector program 125 ... **extracts 220 the Exchange Directory information** 176. Next, the collector program proceeds to **extract 240 registry data** 178 from the Exchange Source Server 174 in step 13, and **retrieves registry data** 182 and 187<sup>42</sup> ... .” Exchange Directory information and registry data is not time-varying data.

“Collector program 125 then creates 250 an HTML page 255, **compresses the data** collected in steps 12 and 13a . . . n, and **encodes 260 the data** for compatibility with transmission using the HTTP protocol. The **data is then embedded in HTML page** 255, preferably as hidden text.<sup>43</sup>” “Once the user sends the **data embedded in HTML page** 255 to the documentation server 100, the program retrieves 310 the information from the web page, **decodes and decompresses 320 the data**.<sup>44</sup>” So, while “raw data is stored in a database 132<sup>45</sup>,” that raw data is not time varying. Therefore, Bakeman et al. also fails to teach “data generation module receiving raw data said raw data being time-varying data, variable data being generated from said time varying data for up to date display;<sup>46</sup>” as the claims recite.

Moreover, dependent claims include all of the differences with the references, as the claims from which they depend<sup>47</sup>. Therefore, claims 9 – 13, 15, 16 and 18 – 25 which depend from claims 8, 14 and 17, are non-obvious over Shiigi et al. in combination with Iizuka et al. and Bakeman et al. Reconsideration and withdrawal of the final rejection to claims 8 – 25 under 35 U.S.C. §103(a) is respectfully requested.

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<sup>42</sup> *Id.*, lines 24 – 30 (emphasis added).

<sup>43</sup> *Id.*, lines 24 – 30 (emphasis added).

<sup>44</sup> *Id.*, col. 11, lines 3 – 6.

<sup>45</sup> *Id.*, line 8.

<sup>46</sup> *Supra.*

<sup>47</sup> MPEP §2143.03 (“If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).”).



The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance for the reasons set forth above, the applicants respectfully request that the Examiner reconsider and withdraw the objection to the specification and final rejection of claims 8 – 25 under 35 U.S.C. §§101, 103(a) and 112 and allow the application to issue.

As the applicants have previously noted, provides in pertinent part that

If **the examiner** is satisfied after the search has been completed that patentable subject matter **has been disclosed** and the record indicates that **the applicant intends to claim** such subject matter, he or she may note in the Office action that **certain aspects or features** of the patentable invention have not been claimed and that if properly claimed such claims **may be given favorable consideration**.<sup>48</sup>

The applicants believe that the written description of the present application is quite different than and not suggested by any reference of record and that the claims as amended reflect those differences. However, should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the local telephone number listed below for a telephonic or personal interview to discuss any other changes. Please charge any deficiencies in fees and credit any overpayment of fees to IBM Corporation Deposit Account No. 09-0449 and advise us accordingly.

Respectfully Submitted,

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(Date)

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<sup>48</sup> MPEP §706 “Rejection of Claims,” subsection III, “PATENTABLE SUBJECT MATTER DISCLOSED BUT NOT CLAIMED” (emphasis added).